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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/869,042	10/03/2001	Unni Olsbye	2001-0768A	2508

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EXAMINER

ILDEBRANDO, CHRISTINA A

ART UNIT	PAPER NUMBER
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1725

DATE MAILED: 05/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/869,042	OLSBYE ET AL.	
	Examiner	Art Unit	
	Christina Ildebrando	1725	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16,18,25-37 and 44-51 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 50 and 51 is/are allowed.
- 6) ☒ Claim(s) 1-16,18,25-37 and 44-49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 7, 2004 has been entered.

Claim Rejections - 35 USC § 102/103

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

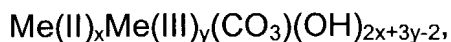
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-5, 7-16, 18, 25-29, 32, 36_{29 or 32}, and 44 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Derouane et al.

Derouane et al. (US 5,245,096) discloses a catalyst composition useful in the preparation of aromatic compounds. The catalyst comprises a Group VIII metal loaded on a hydrotalcite derived support material having the general formula:



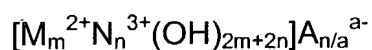
wherein Me(II) is at least one divalent metal selected from the group consisting of copper, magnesium, manganese, zinc, and group VIII metals and Me(III) is at least one trivalent metal selected from the group consisting of aluminum, chromium, and iron (column 1, lines 45-55). Suitable Group VIII metals include platinum (column 3, lines 30-35). The composition may be composited with a binder (column 3, lines 60-69).

The disclosed product of Derouane et al. and the instantly claimed product appear to be essentially the same and are comprised of the same components. In the event any differences can be shown for the product of the product-by-process claims as opposed to the product taught by the prior art, such differences would have been obvious to one of ordinary skill in the art as a routine modification of the product in the absence of a showing of unexpected results. See *In re Thorpe*, 227 USPQ 964 (Fed. Cir. 1985). Also, when the examiner has found a substantially similar product as in the applied prior art, the burden of proof is shifted to applicant to establish that their product is patentably distinct and not the examiner to show the same process of making. *In re Brown*, 173 USPQ 685 and *In re Fessmann*, 180 USPQ 324.

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4. Claims 1-16, 18, 25-29, 32, 36_{29 or 32}, and 44 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Van Broekhoven.

Van Broekhoven (US 4,866,019) discloses a catalyst composition useful in hydrocarbon conversion processes. The catalyst composition comprises an anionic clay having a hydrotalcite structure, corresponding to the general formula:



Suitable divalent cations include magnesium, suitable trivalent cations include aluminum and/or gallium, and suitable anions include OH or CO₃ (column 3, lines 20-45). The composition may be combined with an oxidation promoter such as platinum (column 4, lines 1-10). The composition may be composited with a binder (column 5, lines 40-46).

The disclosed product of Van Broekhoven and the instantly claimed product appear to be essentially the same and are comprised of the same components. In the event any differences can be shown for the product of the product-by-process claims as opposed to the product taught by the prior art, such differences would have been obvious to one of ordinary skill in the art as a routine modification of the product in the absence of a showing of unexpected results. See *In re Thorpe*, 227 USPQ 964 (Fed. Cir. 1985). Also, when the examiner has found a substantially similar product as in the applied prior art, the burden of proof is shifted to applicant to establish that their product is patentably distinct and not the examiner to show the same process of making. *In re Brown*, 173 USPQ 685 and *In re Fessmann*, 180 USPQ 324.

5. Claims 1-5, 7-16, 18, 25-37, and 44-49 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over WO 94/29021.

WO 94/29021 teaches a catalyst composition useful in the dehydrogenation of paraffinic hydrocarbons, such as propane. The catalyst composition comprises a hydrotalcite having a composition $\text{Mg}_6\text{Al}_2(\text{OH})_{16}\text{CO}_3\cdot 4\text{H}_2\text{O}$ in its uncalcined state, which further contains a metal of group VIII such as platinum, a metal of group IV such as tin, and optionally, a group I metal such as cesium (page 2, lines 20-40 and page 3, lines 25-30).

The disclosed product of the WO reference and the instantly claimed product appear to be essentially the same and are comprised of the same components. In the event any differences can be shown for the product of the product-by-process claims as opposed to the product taught by the prior art, such differences would have been obvious to one of ordinary skill in the art as a routine modification of the product in the absence of a showing of unexpected results. See *In re Thorpe*, 227 USPQ 964 (Fed. Cir. 1985). Also, when the examiner has found a substantially similar product as in the applied prior art, the burden of proof is shifted to applicant to establish that their product is patentably distinct and not the examiner to show the same process of making. *In re Brown*, 173 USPQ 685 and *In re Fessmann*, 180 USPQ 324.

Allowable Subject Matter

6. Claims 50-51 are allowed.
7. The following is a statement of reasons for the indication of allowable subject matter: the prior art of record does not teach or suggest a process of preparing a catalyst comprising the instant steps (a) and (b) in combination.

Response to Arguments

8. Applicant's arguments filed May 7, 2004 have been fully considered but they are not persuasive.

With regards to the rejection over Derouane et al., Van Broekhoven et al., and WO 94/29021, applicant appears to be arguing that the cited references do not teach the instant product by process limitations. As discussed above, the product by process limitations have been noted. However, it has been held that even though product by process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product by process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior art product was made by a different process. See *In re Thorpe*, 227 USPQ 964.

Once the examiner provides a rationale tending to show that the claimed product appears to be the same or only slightly different from that of the prior art, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the product of the prior art. Applicant has not met this

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burden. There has been no showing that the product instantly claimed differs structurally or in any way, by virtue of its process of making, from the product taught by the prior art. For example, applicant has not conducted any side by side comparisons with the prior art catalysts, which are commensurate in scope with what has been claimed and which would demonstrate that the claimed compositions do in fact possess a property or characteristic by virtue of its process of making, such as higher stability, as argued herein. The arguments of counsel cannot take the place of evidence in the record. *In re Schulze*, 145 USPQ 716, 718.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christina Ildebrando whose telephone number is (571) 272-1176. The examiner can normally be reached on Monday-Friday, 7:30-5, with Alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Dunn can be reached on (571) 272-1171. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Christina Ildebrando
Patent Examiner
Art Unit 1725

5/17/04

CAI
May 17, 2004